

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed September 1, 2004. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 1-24 stand rejected as obvious over U.S. Patent No. 5,619,709 ("Caid") in view of U.S. Patent No. 5,774,888 ("Light").

In order to establish a prima facie case of obviousness, the Examiner must show: that the prior art references teach or suggest all of the claim limitations; that there is some suggestion or motivation in the references (or within the knowledge of one of ordinary skill in the art) to modify or combine the references; and that there is a reasonable expectation of success. M.P.E.P. 2142, 2143; In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The Examiner must explain with reasonable specificity at least one rejection – otherwise, the Examiner has failed procedurally to establish a prima facie case of obviousness. M.P.E.P. 2142; Ex parte Blanc, 13 U.S.P.Q.2d 1383 (Bd. Pat. Application. & Inter. 1989). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Inter. 1986).

Claim 1 recites "automatically expanding a scope of a search from the first query to a second query based on a hierarchy of keywords associated with the plurality information objects." Claim 7 recites "expanding a scope of a search from the first query to a second query based on a keyword hierarchy," Claim 13 similarly recites "expanding a scope of a search from the first query to a second query based on a hierarchy of keywords" and Claim 19 recites "expanding a scope of a search from the first query to a second query based on a hierarchy of keywords." For this feature of the independent claims, the Examiner points to Caid, col. 15, lines 42-50. Additionally, in response to the previous amendment the Examiner states that "Caid . . . does expand the search within the requested terms by searching the 'sub-icons' which provides more information to the user related to the searched term as disclosed in column 15, lines 42-50."

The passage referred to by the Examiner is describing a graphical method for displaying how well documents match a query for given components of the query. In Caid, a user enters a query, which is separated into its various components. Each component of the query is then assigned a display coordinate or attribute. For example, if five components are identified from the query, the first three may be assigned to the x, y and z axes, and the remaining two may be assigned to the visual attributes of color and texture. The context vector for each component is determined for each component of the query. For each document to be represented in the display, a dot product is determined for the summary vector of the document and the content vector of each component of the query. Once the results are developed for each document to be displayed, the results are supplied to a display engine capable of displaying onscreen icons. The display engine can portray each document as an icon in accordance with the dot product results previously determined. See col. 13, line 32 to col. 14, line 11.

The display engine of Caid can provide a variety of options for displaying documents. The portions of Caid cited by the Examiner discuss one mechanism for reducing visual clutter in the display. For a large number of documents, the display engine can provide a hierarchical organization of the icons. When a user selects an icon for examination, the system erases all icons representing other documents from the display and provides "sub icons" representing the sections, subchapters and/or paragraphs of the selected document. See col. 15, lines 42-49.

Thus, the hierarchy discussed in col. 15, lines 42-50 is the hierarchy representing portions (e.g., the document, chapters, paragraphs) of a document that has already been selected for display. Thus sub-icons represented a more refined view of the document already selected for display. The sub-icons for the document can be displayed in the same manner as the document according to the various display parameters. Therefore, a user can see how specific portions of a document already selected for display fit the components of the query, giving a user a more-refined view of the relationship between the document and the query.

Even though displaying the portions of a document that show a stronger relationship to the various terms of a query may provide more information to a user, it does not expand the scope of the user's search. Instead, it simply provides more information about the documents that were selected for display. In other words, providing additional information about a particular search result is not expanding the scope of the search that lead to the search results in the first place.

Applicant is unable to find any reference in col. 15, lines 42-50 to a hierarchy of keywords. Instead, this portion Caid appears to refer to a document hierarchy (i.e., the fact that a document can contain various defined portions such as chapters and paragraphs). Moreover,

Applicant unable to find any teaching that the display mechanism of col. 15, lines 42-49 expands the scope of the query entered by the user based on a hierarchy of keywords. Rather, by allowing a user to see which portions of a document have the strongest relationship to the various portions of the query, the display mechanism of col. 15, lines 42-49 appears to use the document hierarchy to refine, rather than expand, the results.

With respect to Light, col. 4, lines 60-63 simply state that the scope of terms within a document can be expanded by “adding synonymous terms, such as those found in a thesaurus.” Again, there is no teaching or suggestion that the scope of search should be expanded based on a hierarchy of keywords or a keyword hierarchy as recited in amended Claims 1, 7, 13 and 19.

As the portions of Caid and Light cited by the Examiner do not teach or suggest “expanding the scope of the search . . . based on a hierarchy of key words,” Applicant submits that Examiner has failed to make out a *prima facie* case of obviousness. Applicant therefore requests that the Examiner point out where this feature of the present invention can be found in the cited references or allow Claims 1, 7, 13 and 19 and the respective dependent claims.

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of the Claims. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

Sprinkle IP Law Group
Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'John L. Adair', is written over the printed name.

John L. Adair
Reg. No. 48,828

Date: Dec. 1, 2004.

P.O. Box 684767
Austin, TX 78768
Tel. (512) 637-9220
Fax. (512) 371-9088